



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,963	07/10/2001	Claudine Guerin-Marchand	010830-118	8667

21839 7590 08/29/2003

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 08/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,963

Applicant(s)

GUERIN-MARCHAND ET AL.

Examiner

Shanon Foley

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 27-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant should note that currently, claims 28 and 31 are unsearchable because they refer to sequences by Figure number and do not identify a SEQ ID NO: as required by 37 CFR 1.182. In addition, claim 37 refers to claim 44, but there is no claim 44 pending in the application.

It is also noted that the specification fails to adhere to the requirements of the sequence rules. Applicant must append SEQ ID Nos. to all mentions of specific sequences in the specification and the claims. See 37 CFR § 1.821 (a)-(d) and MPEP § 2422.

Appropriate correction is urged in response to this restriction requirement to avoid rejections concerning these issues upon examination on the merits.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 27, 28 and 35, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of Figure 9, classified in class 536, subclass 23.7.
- II. Claims 27, 28 and 35, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of Figure 10, classified in class 536, subclass 23.7.
- III. Claims 27, 29, 30, 35 and 37, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of SEQ ID NO: 19, classified in class 536, subclass 23.7.

- IV. Claims 27, 29, 30, 35 and 37, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of SEQ ID NO: 20, classified in class 536, subclass 23.7.
- V. Claims 27, 29, 30, 35 and 37, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of SEQ ID NO: 21, classified in class 536, subclass 23.7.
- VI. Claims 27, 29, 30, 35 and 37, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of SEQ ID NO: 22, classified in class 536, subclass 23.7.
- VII. Claims 27, 29, 30, 35 and 37, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of SEQ ID NO: 23, classified in class 536, subclass 23.7.

If applicant elects any of inventions III-VII, applicant must also elect an amino acid sequence that precedes the elected DNA sequence encoding the polypeptide selected from SEQ ID NOs: 2-18, recited in claim 30. Applicant should note that this is not a species election.

- VIII. Claims 27, 31 and 35, drawn to a DNA sequence encoding a polypeptide consisting of the amino acid sequence of Figure 7, classified in class 536, subclass 23.7.
- IX. Claims 27, 32-35 and 37, drawn to a DNA sequence encoding a polypeptide consisting of the first 153 amino acids of SEQ ID NO: 37, classified in class 536, subclass 23.7.

Art Unit: 1648

If applicant elects invention IX, applicant must also elect one amino acid sequence that precedes and one amino acid sequence that follows the elected DNA sequence encoding the polypeptide selected from SEQ ID NOs: 2-18, recited in claims 33 and 34, respectively. Applicant should note that this is not a species election.

- X. Claims 27, 35 and 36, drawn to a DNA sequence encoding a polypeptide consisting of the last 279 amino acids of SEQ ID NO: 45, classified in class 536, subclass 23.7.

The inventions are distinct, each from the other because of the following reasons:

Claims 27 and 35 are generic claims, and as such, have been combined with each of the individual inventions.

Inventions comprising SEQ ID NOs: 2-18 and I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I-X are structurally and functionally distinct DNA sequences that encode different polypeptides. Therefore, each of the DNA sequences has different effects. Inventions comprising SEQ ID NOs: 2-18 are also structurally and functionally distinct because each are drawn to different amino acid sequences, as evidenced by separately designated SEQ ID NO. Inventions I-X comprise nucleic acid sequences, while the separate inventions comprising SEQ ID NOs: 2-18 comprise amino acid residues. Therefore, I-X and SEQ ID NOs: 2-18 structurally and functionally divergent.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for

Art Unit: 1648

examination purposes as indicated is proper. Each invention requires a separate search because of the unique physical properties of each molecule.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (703) 308-3983. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Shanon Foley